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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,908	01/22/2001	Christoph Heller	CU-2409 VE	1606

7590 06/23/2004

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EXAMINER

OLSEN, KAJ K

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Advisory Action	Application No. 09/701,908	Applicant(s) HELLER ET AL.	
	Examiner Kaj K Olsen	Art Unit 1753	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached discussion.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5-26-2004 have been fully considered but they are not persuasive. Applicant continues to urge that Sundberg does not qualify as prior art under 35 U.S.C. 102(e) because the examiner cannot rely on the earlier filing date of the continuation application. This is incorrect. When an application is a continuation or a divisional of an earlier application, the presumption is that all the conditions of 35 U.S.C. 120 were met and all the disclosure of the continuation or divisional application was disclosed in the earlier parent application. See MPEP 201.07 and 706.02(i). The examiner is aware of no discussion in the MPEP that requires the examiner to perform a careful comparison between the two disclosures to determine if a reference is entitled to its earlier effective filing date. However, a cursory review of 6,090,251 indicates that everything the examiner relied on in Sundberg was present in the earlier filed application. If the applicant believes the examiner of 09/274,811 made a mistake and permitted subject matter that was not in the earlier application, **and** that new subject matter includes what the examiner relied on in Sundberg, then the applicant is invited to evidence that the publication of 08/870,944 does not disclose what the examiner relied on. Until such evidence, Sundberg is entitled to an effective filing date of 6-6-1997.

2. Applicant also continues to urge that Sundberg fails to teach an application area. To support that argument, applicant urges that the application area of Sundberg is not configured for taking samples by means of a micro-dispenser. The examiner is confused by this point. What precisely is lacking in Sundberg that would make it incapable of taking sample via a micro-dispenser? The applicant doesn't appear to ever elaborate what precisely is lacking in Sundberg.

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Sundberg teaches the use of both pipettes and pins for delivering sample to the ports (col. 4, lines 65-67 and col. 5, lines 46-65). These devices read on applicant's claimed micro-dispenser.

3. Applicant's argument concerning Parce appears to be an elaboration on the same argument the applicant previously made concerning this teaching in the paper dated 12-8-2003.

The examiner dealt with this issue in paragraph 26 of the final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (571) 272-1344. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 4:00 P.M. and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kaj Olsen Ph.D.
Primary Examiner
AU 1753
June 22, 2004